

### **REMARKS**

This responds to the Office Action mailed on February 22, 2008.

Claims 9, 14, and 34 are amended, claim 10 is canceled, and no claims are added; as a result, claims 1-9, 13-15, 33, and 34 are now pending and subject to examination in this application.

#### **§101 Rejection of the Claims**

Claim 14 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Per the suggestion in the Office Action that encourages the Applicant to amend claim 14 to include hardware, the Applicant has amended claim 14 to recite “a processor configured” to execute the functions of claim 14. Support for this amendment can be found in the specification at least at page 5, lines 4-9 and in FIG. 1, No. 118.

The Applicant respectfully submits that the amendment to claim 14 addresses the rejection of claim 14 under 35 U.S.C. § 101, and respectfully requests the withdrawal of this rejection.

#### **§103 Rejection of the Claims**

Claims 9 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617) in view of Hull et al. (U.S. Patent No. 6,687,404).

The Office Action indicated that claim 10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 is dependent on independent claim 9. The Applicant has amended claim 9 to include all the limitations of claim 10, and canceled claim 10. The Applicant respectfully submits that this amendment overcomes the rejection of claim 9, and respectfully requests the withdrawal of the rejection of claim 9.

The Applicant has amended claim 14 to recite a “processor configured for converting one of the candidate paths into a language described by the document type definition.” The Applicant respectfully submits that this amendment to claim 14 renders claim 14 substantially similar to claim 1. Since claim 1 has been allowed, the Applicant further respectfully submits

that claim 14 is now in a condition for allowance, and respectfully requests the withdrawal of the rejection of claim 14.

Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617) in view of Yamakawa et al. (U.S. Patent No. 5,907,851). The Applicant respectfully traverses this rejection.

In the rejection of claim 33, the Office Action specifically conceded that Wanderski omits a teaching of “providing a set of two or more DTDs, and selecting one for conversion,” but asserted that Yamakawa “teaches document conversion utilizing preparation of a plurality of ... DTDs for switching and development of one or more DTDs.” (Yamakawa, column 22, lines 22-32, Figure 67). Further, the Office Action contended that it would have been obvious to apply Yamakawa to Wanderski to provide “the benefit of predefined DTD selection for eventual adherence to various established standards.”

However, the proposed motivation is not applicable to Wanderski. Wanderski reports “a method, system, and computer-readable code for ... creating an Extensible Markup Language, or XML dialect ... and then dynamically generating a document type definition for this XML dialect.” (Column 1, lines 16-23). As such, it appears that one of skill would view the provision and selection of a DTD from multiple DTDs to be contrary to the teachings of Wanderski. Wanderski reports dynamic *generation* of customized DTDs, not the *selection* of a DTD from multiple DTDs. Therefore, if one of skill were to combine Yamakawa with Wanderski, Wanderski’s operation would be changed from the generation of a customized DTD to the selection of a DTD from multiple DTDs. If a proposed combination in an obviousness analysis changes the principle of operation of a reference, that combination is improper. (*See* MPEP, § 2143.02, Part VI, When proposed modification of prior art changes the principle of operation of the prior art (*i.e.*, it is contrary), a *prima facie* case of obviousness has not been made.) Consequently, Wanderski and Yamakawa are not properly combinable, and as such, one of skill in the art considering the Wanderski and Yamakawa references at the time that the presently claimed subject matter was made would not have been led to come up with the presently claimed subject matter. Consequently, the Applicant respectfully requests the withdrawal of the rejection of claim 33.

Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wanderski et al. (U.S. Patent No. 6,519,617) in view of Nakao (U.S. Patent No. 6,061,697).

The Applicant has amended claim 34 to contain the limitations of allowed claim 1. The Applicant respectfully submits that claim 34 is now in a condition for allowance, and respectfully requests the withdrawal of the rejection of claim 34.

*Allowable Subject Matter*

Claims 1-8, 13 and 15 were allowed.

Claim 10 was objected to as being dependent upon a rejected base claim, but was indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicant has amended claim 9 so that all the limitations of claim 10 have been incorporated into claim 9. The Applicant respectfully submits that this places claim 9 into a condition for allowance, and respectfully requests a notice to that effect.

*Reservation of Rights*

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of

the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2140 to facilitate prosecution of this application.

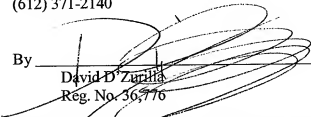
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date May 22, 2008

By

  
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22<sup>nd</sup> day of May 2008.

Jonathan Ferguson

/ Jonathan Ferguson /

Name

Signature